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EXAMINER

NGUYEN, LE V

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/757,006
Filing Date: January 08, 2001
Appellant(s): GEIER ET AL.

Burns, Doane, Swecker & Mathis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/5/06 appealing from the Office action
mailed 12/2/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Screen Dumps of Microsoft Windows 4.0		1998
6,301,586	Yang et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 85, 86 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Screen Dumps of Microsoft Windows ("MS Win").

As per claim 85, MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium, comprising:

at least one window that defines an area onto which a user can drag and drop one or more files to be recorded on a removable storage medium, the files being displayed within the area as icons (fig. 1; *with cursor, highlighted file 110 is dragged and dropped to window 120 to be recorded on a removable storage medium via drive A, element 130*);

a control element on the window that enable a user to select from among a plurality of different themes for displayed features of the defined area and the

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icons (fig. 2; *"View"/control element 210 enables a user to select from among a plurality of themes such as "Large Icons" (220), "Small Icons" (230), "List" (240) and "Details" (250)); and*

a recording control element which, when activated by a user, causes the content of the files in the defined area to be recorded on a removable storage medium (fig. 1: *by right clicking on an icon such as icon 140 and selecting the recording control element "Send To > 3 ½ Floppy (A:)", users may record the content of the files on a removable storage medium (not shown).*

As per claim 86, MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium wherein the window includes a control element which, when activated by a user, causes a folder icon to be displayed in the defined area onto which the user can drag and drop data files to be recorded on a removable storage medium (fig. 1: *although not depicted, drop down menu displays upon selection of "▼" (150), and user's selection of a control element within the menu causes folder icon(s) to be displayed in the defined area onto which the user can drag and drop data files to be recorded on a removable storage medium).*

As per claim 88, MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium wherein the shape of the icons is determined by the selected theme (figs. 1-2: *e.g. "Large Icons" as depicted in fig. 2 or "Details" as depicted in pane 160 of fig. 1).*

As per claim 89, MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium wherein the defined area is displayed with a background image that is determined by a selected theme (figs. 1-2: *a white background image is associated with each theme (220-250)*).

Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Screen Dumps of Microsoft Windows ("MS Win") in view of Yang et al. ("Yang").

As per claim 87, although MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium wherein the window includes a control element that, when activated by a user, causes an icon to be displayed in the defined area onto which the user can drag and drop image files to be recorded on a removable storage medium in various file formats, MS Win does not explicitly disclose the format to be a slideshow format for presentation on a media playback device. Yang teaches dragging and dropping image files onto an album thumbnail/icon to be stored on a storage medium in a slideshow format for playback (col. 4, line 46; col. 5, lines 63-65; col. 23, line 63 through col. 24, line 9). Therefore, it would have been obvious to an artisan at the time of the invention to include Yang's teaching of dragging and dropping image files onto an album thumbnail/icon to be stored on a storage medium in a slideshow format for playback to MS Win's teaching of dragging and dropping image files onto an icon to be recorded on a removable storage medium in various formats so that users are not constrained to a limited number of file formats.

Claims 90 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Screen Dumps of Microsoft Windows ("MS Win").

As per claims 90 and 91, although MS Win teaches a GUI on a computer-readable medium for assembling and recording media files on a removable storage medium wherein the recording control element causes the files in the defined area to be stored on a removable storage medium, MS Win does not explicitly disclose, the removable storage medium to be a DVD or CD. Official Notice is taken that storing file data on a removable storage medium such as a DVD or CD is well known in the art. Therefore, it would have been obvious to an artisan at the time of the invention to include storing file data on a removable storage medium such as a DVD or CD to MS Win's teaching of storing file data on a removable storage medium given that DVDs and CDs have greater storage capacities as required by audio/video multimedia.

(10) Response to Argument

Appellant argued:

(a) The menu shown in Figure 2 is not depicted in connection with that window, let alone "on" the window. Rather, it is shown on the desktop as a completely different window; the browser window 120 does not even appear in the screen image of Figure 2; the disparate and disassociated windows of Figures 1 and 2 cannot be interpreted to disclose the control element. Moreover, there is no showing in the Office Action that the objects in the window of Figure 2 are the same as the objects shown in Figure 1, nor is there any showing that the "View" command of the Figure 2 window has any effect upon

the icons in the window of Figure 1 even though different object may have different shapes. Although the size of the icon changes from one view to another, the different options available under the "View" menu do not affect the shape of the icons that are displayed.

(b) Microsoft Windows does not teach displaying a defined area with a background image that is determined by the selected theme, since the same background image is associated with each theme.

(c) In regards to the rejections of claims 90 and 91, "the Office Action does not provide any evidence to support the rejection...that the recording element recited in claim 85 causes the files in said defined area of the interface window to be burned onto the disk" or that files could be recorded on a DVD, or a CD, by simply dropping and dragging them within a browser window.

(d) The Yang patent does not relate to the recording of multimedia objects onto a removable storage medium, i.e. a UI having a control element that causes a slide show icon to be displayed onto which the user can drag and drop multimedia files and have them recorded on the removable storage medium in the format of a slideshow for presentation on a playback device.

The examiner disagrees for the following reasons:

Per (a), Microsoft Windows operating system, as representative of the Screen Dumps captured in figs. 1-2, allows user navigation and user folder selection among a plurality of selectable folders comprising the feature of displaying a "View" control

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element located on the window such as displayed on window 120 (fig. 1; as *indicative of the address "C:\APPS\Office97\Templates\A..."*, the contents of a folder within folder "APPS" are displayed wherein the folders are stored on the "C:" drive) and window 210 (fig. 2; as *indicative of the address "C:\INSS\ ..."*, the contents of a folder within folder "INS" are displayed wherein the folders are stored on the "C:" drive) with a menu displayed in connection with a window such as "View" drop down menu displayed in connection with window 210 in fig. 2 upon selection of a control element such as "View" control element. Moreover, the menu as depicted in fig. 2 is also displayed on the window.

Furthermore, displayed within the same browser window of the user's desktop are contents of a folder nested within folders "APPS", "Office97" and "Templates" of a user's "C:\\" drive (fig. 1) and contents of a folder nested within folder "INSS" of the user's "C:\\" drive (fig. 2). Microsoft Windows operating system allows users to view a folder's content via clicking on a folder in a desktop window (fig. 1) or typing in a folder address of the same desktop window (fig. 2). Therefore, figs. 1 and 2 are not disparate and disassociated windows since control element "View" of fig. 1 is the same control element "View" of fig. 2 of the same desktop window, only the content of the folder displayed or objects representing files within the folder displayed differ/change upon user selection of another folder. Moreover, the described feature as taught by Microsoft Windows operating system also includes a menu in connection with the browser window upon selection of the "View" control element within figs. 1 (*not displayed*) and 2 of the Screen Dumps of Microsoft Windows.

Lastly, as shown in fig. 2, the selected theme such as 230 is "Small Icons" thus, displayed within the window are icons that are representative of small icons. It appears by appellant's arguments that although claim 88 does not explicitly claim changing the shape of icons upon changing a selected theme, appellant would like to convey the possibility of new icons being displayed in a changed shape as a resultant of changing the displayed theme results. If appellant had hoped that by "shape of said icons is determined by the selected them" as recited in claim 88 to imply changing the shape of icons upon changing a selected theme to include the possibility of changing the displayed theme would result in new icons being displayed in a changed shape, appellant is invited to amend the claim language to explicitly recite such claim language.

Per (b) and as taught by Microsoft Windows operating system within figs. 1 and 2 of the Screen Dumps of Microsoft Windows, displayed is the general scene or surface against which designs, patterns or figures are represented or viewed, or (in computer science) the area of the screen in graphical user interfaces against which icons and windows appear (<http://dictionary.reference.com/browse/background>). Therefore, the defined area is displayed with a background image of fig. 2 that is determined by the selected theme such as 230.

Per (c), in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., to be burned onto the disk) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). While Microsoft Windows operating system within fig. 1 of the Screen Dumps of Microsoft Windows teaches an area onto which a user can drag and drop one or more files to be recorded on a removable storage medium as recited in claims 85-87 (fig. 1; *with cursor, highlighted file 110 is dragged and dropped to window 120 to be recorded on a removable storage medium via drive A, element 130*), the examiner took official notice of the fact that recording information on a DVD or CD is well known. The examiner has included a supplemental reference in support of the Official Notice that recording information on a DVD or CD is well known to an artisan at the time of the invention; since, if official notice was used in a new grounds of rejection that is made final, then a challenge after final is permissible.

Furthermore, appellant argues that a separate application is needed in 1998 to accomplish the burning; however, appellant's claims fail to recite this feature.

Per (d), in response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Microsoft Windows operating system within figs. 1 and 2 of the Screen Dumps of Microsoft Windows teaches a control element on the window that enable a user to select from among a plurality of different themes for displayed features of the defined area and the icons (*"View"/control element enables a user to select from among a plurality of themes, e.g. "Large Icons" (220), "Small Icons" (230), "List" (240) and "Details" (250)*) and a recording control element which, when activated by a user,

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causes the content of the files in the defined area to be recorded on a removable storage medium (fig. 1: *by right clicking on an icon such as icon 140 and selecting the recording control element "Send To > 3 ½ Floppy (A:)"*, users may record the content of the files on a removable storage medium (not shown)) as recited in claim 85. The feature extracted from the teachings of Yang was for a slideshow format for presentation on a media playback device (col. 4, line 46; col. 5, lines 63-65; col. 23, line 63 through col. 24, line 91).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lê Nguyen

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